



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,880	09/28/2001	John S. Hendricks	3960.D18	2103

38598 7590 07/22/2005

ANDREWS KURTH L.L.P.  
1701 PENNSYLVANIA AVENUE, N.W. SUITE 300  
WASHINGTON, DC 20006

EXAMINER

VO, TUNG T

ART UNIT PAPER NUMBER

2613

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/964,880

Applicant(s)

HENDRICKS, JOHN S.

Examiner

Tung Vo

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10, 11, 13-21 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 12, 22, is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-11, 13-21, 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 10-29 of this application.

Applicant has claimed priority from application 07/991,074 filed on 12/09/1992. However, applicant is not entitled to the priority of the cited application as he fails to provide adequate support for the claims in the present application filed on 11/07/1994. The new priority date for this application is from application 08/336,247.

In the remarks filed 05/12/2005, the applicant enclosed the pages 50 and 36 from of the application 07/991,074 to support the claims 10 and 20 of the application 09/964,880 for the priority date.

The examiner respectfully disagrees with the applicant. It is submitted that the entirety application 07/991,074 does not disclose a method for providing electronic books displayed on small portable viewers. The term, "electronic book", is not disclosed anywhere in the application 07/991,074, see also figures 1-134. Furthermore, the application 09/964,880 discloses an electronic book in figures 1-3, 14s-14t, 15, 18a, and 18b. In view of the discussion above, the new priority date for this application 09/964,880 is from application 08/336,247.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 10, 15, 17, 20, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Fernandez (US 4,855,725).

Re claims 10 and 20, Fernandez discloses a method for providing electronic books (30 of fig. 2A) displayed on small portable viewers (col. 3, lines 8-35), comprising.

receiving (10, 26 of fig. 3) text material for a plurality of electronic books in a plurality of formats (22 of fig. 3);

converting (26 of fig. 3) the text material in the plurality of formats to a compressed video format, storing the plurality of electronic books in the compressed video format (col. 3, lines 63-col. 4, line 5); and

providing (26 of fig. 3) the electronic books to users (subscribers) (users simultaneously access different portions of the database simultaneously, see col. 3, lines 13-18) in the compressed video format via the small portable viewers; a standard compressed format (26 of fig. 3, e.g. a text is converted to a standard encoded format).

Re claim 15, Fernandez further discloses wherein the providing step includes electronically communicating with the small portable viewers for providing the electronic books (30 of fig. 2A; see also fig. 3).

Art Unit: 2613

Re claim 17, Fernandez further discloses a keypad (36 of fig. 3) including displaying a menu (keypad allows a user to input a request to the computer (10 of fig. 3; see also fig. 4)) on the small portable viewers providing indications of the electronic books.

Re claim 18, Fernandez further discloses a keypad that further including generating a textual signal (a request signal from the CD book (30 of fig. 3) to the computer (10 of fig. 3) for providing the text material (page of the book including the text material) and a menu signal for providing the menu (keypad (36 of fig. 3); see also fig. 4).

Re claim 25, Fernandez further discloses the step that includes electronically communicating with the small portable electronic books (the computer (10 of fig. 3) communicate with the CD books (30 of fig. 2A) and other portable CD books, col. 3).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 13, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez (US 4,855,725) in view of Litteral (US 5,247,347).

Re claims 11, 13 and 23, Fernandez suggests the step converting the text into a compressed, encoded, format (26 of fig. 3) but not a format according to the MPEG standard as claimed.

However, Litteral teaches the step of converting the text into the digital format according to the MPEG standard (col. 7, lines 38-45, e.g. MPEG encoder encodes the text into the digital or compressed format).

Taking the teachings of Fernandez and Litteral as a whole, it would have been obvious to one of ordinary skill in the art to incorporate the MPEG standard format of Litteral into the encoder/decoder (26 of fig. 3) Fernandez for the same purpose of compressing the electronic (digital) books into the compressed electronic book accordance to the MPEG standard to save the capacity of the memory.

Doing so would improve the availability of electronic book service to the public.

6. Claims 14, 16, 19, 24, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez (US 4,855,725) in view of Ross (US 5,465,213).

Re claims 14, 16, 19, 24, and 26-29, Fernandez further suggests multi-users to download the electronic books (fig. 4) to the portable CD book (30 of fig. 2A) for reading (col. 3, lines 7-35), Fernandez does not particularly teach or suggest the steps of providing the text material by titles of the corresponding electronic books, permitting subscribers to purchase the electronic books via the viewers and portable viewers that includes a menu on viewers to provide indications of electronic books as claimed.

However, Ross teaches the steps of grouping the text material by titles of the corresponding electronic books (fig. 5), permitting subscribers (users) to purchase the electronic books via the viewers (col. 7, lines 24-64); electronically communicating with portable viewers (costumer module (103 of fig. 3) is a self-contained assembly of electronic components and circuitry, as a

Art Unit: 2613

stage in a computer, which would be made in a portable or handheld device as suggested by Fernandez (30 of fig. 2A)) for providing the electronic books (105 and 103 of fig. 3), displaying a menu on the viewers providing indications of the electronic books (col. 7, lines 24-64, e.g. displaying the menu, book, titles, authors); generating a textual signal for providing the text material and a menu signal for providing the menu (col. 7, lines 35-46).

Taking the teachings of Fernandez and Ross as a whole, it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Ross into the apparatus of Fernandez to easily purchase the electronic books using the menu display on the portable module at the remote location.

Doing so would provide the electronic book system for everyone to easily purchase and hold a large inventory of books for a retail store or mail order catalogue, to reduce floor space requirements, to provide for reduction of the number of employees needed to run a retail book store, to provide for the reduction of shopping costs, employee pilferage costs, damage to inventory and dead inventory costs as well as shipping costs associated with the operation of a retail as suggested by Ross (col. 3).

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 2613

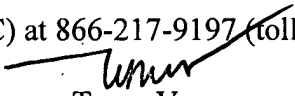
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tung Vo whose telephone number is 571-272-7340. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tung Vo  
Primary Examiner  
Art Unit 2613